



3438 US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

USA PCT National Stage Patent Application  
PCT/EP97/02086 filed April 24, 1997

Thomas Hopf, et al

Serial No.: 09/269,148

First Submission: Filed March 12, 1999

METHOD FOR THE DETERMINATION OF COMBUSTION MISFIRES

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CERTIFICATE OF MAILING ON LAST PAGE  
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Hon. Commissioner of Patents & Trademarks  
Washington, D.C. 20231

S I R :

RESPONSE TO 1) NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC  
371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)  
AND 2) NOTIFICATION OF DEFECTIVE OATH OR DECLARATION, AND 3)  
RESPONSE TO DECISION ON PETITION, AND SUBMISSION OF  
DECLARATION AND SURCHARGE

In response to the Office Action (copy enclosed) dated November 8, 1999, and Decision on Petition dated June 5, 2001, respectfully submitted herewith is the signed and dated Combined Declaration of the inventors (2 pages) in compliance with 37 CFR 1.63 and 1.66 or 1.68 and 37 CFR 1.497(a) and (b), identifying the application by PCT International application no. and international filing date and with power of attorney.

Enclosed is check 13878 \$130.00 the surcharge fee for providing the oath or declaration later than the appropriate 30 months from the earliest priority filing date.

The English translation of the PCT application and the Preliminary Amendment were submitted on March 12, 1999. Please enter the Preliminary Amendment before calculating claim fees.

The Commissioner is hereby authorized to charge any or additional fees which may be required, or credit any overpayment to deposit account no. 06-0105.

Respectfully submitted,

Thomas Hopf et al

by:

MARTIN A. FARBER  
Attorney for Applicants  
Registered Representative  
Registration No. 22,345

CERTIFICATE OF MAILING UNDER 37 CFR SECTION 1.8(a)

I hereby certify that the accompanying Response to Notification of Missing Requirements under 35 USC 371 in the United States Designated/ Elected Office (DO/EO/US) and Notification of Defective Oath or Declaration, signed Combined Declaration (2 pages), and check 13878 \$130.00 surcharge are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents & Trademarks, Washington, D.C. 20231, on July 3, 2001.

Dated: July 3, 2001

Martin A. Farber

866 United Nations Plaza  
Suite 473  
New York, NY 10017  
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17/12/2001 11:44:34 AM 1000002 02009140  
01/01/04 130.00 0P



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PCT/EP97/02086

UNITED STATES PATENT AND TRADEMARK OFFICE

**DUE JULY 5, 2001**

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Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

In re Application of HOPF et al  
U.S. Application No.: 09/269,148  
Int. Application No.: PCT/EP97/02086  
Int. Filing Date: 24 April 1997  
Priority Date: 12 September 1996  
Attorney Docket No.: 3438 US  
For: METHOD FOR THE DETERMINATION  
OF COMBUSTION MISFIRES

**DECISION ON PETITION**

This is in response to applicants' "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action Under MPEP 711.03(c) II" filed 29 January 2001.

**BACKGROUND**

On 24 April 1997, applicants filed international application PCT/EP97/02086, which claimed priority of an earlier Germany application filed 12 September 1996. A copy of the international application was communicated to the USPTO from the International Bureau on 19 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 January 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 March 1999.

On 12 March 1999, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 November 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 03 October 2000, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the present application is abandoned based on applicants' failure to respond to the Notification of Missing Requirements mailed 08 November 1999.

On 29 January 2001, applicants filed the present petition. The petition states that the Notification of Missing Requirements was not received by applicants' representative and that a search of the application file jacket and docket records indicates that the Notification of Missing Requirements was not received. The petition further states that it is accompanied by a copy of a docket record where the Notification of Missing Requirements would have been entered had it been received and docketed.

### DISCUSSION

According to the Official Gazette at 1156 OG 53 and MPEP 711.03(c), a petition to withdraw a holding of abandonment based on failure to receive an Office communication must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

With regard to item (1) above, applicants' representative has provided the required statement.

With regard to item (2) above, applicants' representative has provided the required statement.

With regard to item (3) above, in order to satisfy the evidentiary requirements necessary for a withdrawal of the holding of abandonment, applicants should furnish a docket record listing the responses due to the USPTO on 08 December 1999 for all cases handled by the representative's firm. In the present case, the petition states that the submitted copy of the attorney's office docket record reflects "all due date docket entries". The copy of the docket record shows no entry for a response due to a Notification of Missing Requirements on 08 December 1999.

### CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment is GRANTED.

Accordingly, the holding of abandonment in the present application is hereby WITHDRAWN and the Notification of Abandonment mailed 03 October 2000 is hereby VACATED.

The application will be forwarded to the DO/EO/US for processing in accordance with this decision. Copies of the Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) and the Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), which were originally mailed on 08 November 1999, are attached to this decision. Applicants are required to respond to the Notification of Missing Requirements within ONE (1) MONTH from the mailing date of this decision. Extensions of time are available under 37 CFR 1.136(a).



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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Box PCT  
Washington, D.C. 20231



U.S. APPLICATION NO.		FIRST NAMED APPLICANT	ATTY. DOCKET NO.
JUL 08 2001	09/269148	HOPF	T 3438 US
MARTIN A FARBER UNITED NATIONS PLAZA SUITE 473 NEW YORK, NY 10017		INTERNATIONAL APPLICATION NO.	
		PCT/EP97/02086	
		I.A. FILING DATE	PRIORITY DATE
		24 APR 97	12 SEP 96
		DATE MAILED: 08 NOV 1999	

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as:  
 a Designated Office (37 CFR 1.494),  
 an Elected Office (37 CFR 1.495):  
  
 U.S. Basic National Fee.  
 Copy of the international application in:  
 a non-English language.  
 English.  
 Translation of the international application into English.  
 Oath or Declaration of inventors(s) for DO/EO/US. \* UNSIGNED \*  
 Copy of Article 19 amendments.  
 Translation of Article 19 amendments into English.  
 The International Preliminary Examination Report in English and its Annexes, if any.  
 Translation of Annexes to the International Preliminary Examination Report into English.  
 Preliminary amendment(s) filed 12 MAR 1999 and \_\_\_\_\_.  
 Information Disclosure Statement(s) filed 12 MAR 1999 and \_\_\_\_\_.  
 Assignment document.  
 Power of Attorney and/or Change of Address.  
 Substitute specification filed \_\_\_\_\_.  
 Verified Statement Claiming Small Entity Status.  
 Priority Document.  
 Copy of the International Search Report  and copies of the references cited therein.  
 Other:
2. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:
  - a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.  
 The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
  - b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
  - c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.  
 The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
  - d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).
3. Additional claim fees of \$ \_\_\_\_\_ as a  large entity  small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. See attached PTO-875.

ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY  21 OR  31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.
5.  The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR. 494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

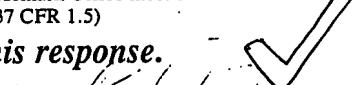
*A copy of this notice MUST be returned with this response.*

Enclosed:

PCT/DO/EO/917  
 PTO-875

Notice of Defective Translation

FORM PCT/DO/EO/905 (December 1997)

  
Karen McLean, Paralegal

Telephone: 703-308-9117



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Tradem. Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

U.S. APPLICATION NO.		FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/269148		HOPF	T 3438 US
MARTIN A FARBER 866 UNITED NATIONS PLAZA SUITE 473 NEW YORK, NY 10017		INTERNATIONAL APPLICATION NO.	
		PCT/EP97/02086	
		I.A. FILING DATE	PRIORITY DATE
		24 APR 97	12 SEP 96

JUL 06 2001

U.S. PATENT & TRADEMARK OFFICE

### NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1.  is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2.  does not identify the specification to which it is directed.
3.  does not identify the inventor(s).
4.  does not identify the citizenship of each inventor.
5.  does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1.  does not identify the city and state or city and foreign country of residence of each inventor.
2.  does not state that the person making the oath or declaration:
  - a.  has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
  - b.  acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3.  does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4.  does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).

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